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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,080	12/31/2003	Uzair Siddiqui	G&C 130.64-US-II	1879

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EXAMINER
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NATNITHADHA, NAVIN

ART UNIT	PAPER NUMBER
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3735

MAIL DATE	DELIVERY MODE
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07/13/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/750,080

Applicant(s)

SIDDIQUI ET AL.

Examiner

Navin Natnithithadha

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 1-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :20040527;20050222;20050503;20051028.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group II, claims 37-51, in the reply filed on 30 May 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1-36 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

This application contains claims 1-36 drawn to an invention nonelected without traverse filed on 30 May 2007. A complete reply to this Office Action must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Priority***

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The disclosure of the prior-filed application, Application No. 10/034,139, fails to provide adequate support or enablement in the manner provided by the first paragraph

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of 35 U.S.C. 112 for one or more claims of this application. The prior-filed application fails to provide support for “determining a status of the monitor for receiving the signal from the sensor,” “a display for showing an observable indicator of the status of the monitor,” and “wherein the status is based upon at least one condition of the group comprising a sensor activity condition, a sensor calibration condition and a telemetry condition” (see claim 37).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 37, 42, 43, 50, and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Schulze et al, US 6,893,396 B2 (“Schulze”).

Claim 37, 42, and 43: Schulze teaches a physiological characteristic monitor (“portable data monitor,” “PDM”) 12A, comprising: a sensor input capable of receiving a signal from a sensor 32, 34, 35, or 36 (see fig. 5), the signal being based on a sensed physiological characteristic value (for example, blood oxygen saturation level, pulse rate, ECG, and body temperature, but not limited to these physiological parameters, and thus, include glucose, see col. 6, ll. 30-36) of a user; a processor 590 for determining a

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status of the monitor for receiving the signal from the sensor ("PDM further monitors its own internal status," see col. 15, l. 10), wherein the status is based upon at least one condition of the group comprising a sensor activity condition ("status of measurement systems," see col. 15, l. 11), a sensor calibration condition and a telemetry condition, i.e. a no synchronization indicator ("communication signal status," see col. 15, l. 14); and a display 100 for showing an observable indicator 86, 84, or 74 of the status of the monitor and time 72 (see figs. 4 and 5, and col. 16, ll. 51-67).

Claims 50 and 51: Schulze does not specifically teach the claimed subject matter.

However, the claimed subject matter is directed to the intended use of the display. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Clearly, Schulze's display 100 is capable of displaying data regarding a value and time of most recent valid reference measurement.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 39, 40, 41, and 44-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulze, as applied to claim 37 above, and further in view of over Reuss et al, US 7,048,687 B1 ("Reuss").

Claims 39, 40, 41, and 44-49: Schulze does not teach a "calibration pending indicator" (claim 39), a "sensor replacement prompt" (claims 40 and 48), a "enter characteristic measurement prompt" (claim 44), a "characteristic measurement due prompt" (claim 46). Schulze teaches the display 100 shows the time 72. However, Reuss teaches the following:

(a)

If, in Step 40, no acknowledgment is received, the controller 16 of the medical device 12 will determine that the medical probe 14 currently attached is an incorrect medical probe or is not functional. Preferably, in Step 41 the controller 16 will provide a message to the display 20, such as "Replace Probe", and/or will emit an audible alarm (medical alarm) to the audio output 17...

If the probe fails the functional tests, the method defaults to Step 41 and a violation message, describing the functional test failure is described, and a message indicating "Replace Probe" is written to display 20 and/or an

audible alarm is generated by audio output 17. Functions of the medical device 12 related to this medical probe 14 are inhibited until another probe is connected to the medical device 12.

See col. 10, ll. 42-56, and col. 11, ll. 59-64 (emphasis added, passages teaches a “sensor replacement prompt”); and

(b)

[T]he medical device 12 can adjust parameters and algorithms to match the specific functional requirements of the medical probe 14. Such parameters for sensor devices 24 include dynamic range, signal processing characteristics, probe calibration, medical alarm limit values, display content and format, trend data storage content and format, and network communications content and format. In a pulse oximeter sensor, the parameters may include LED emission characteristics (e.g., center wavelength(s) and spectrum width(s)), calibration table (normalized ratio versus SPO.sub.2 value), and detector characteristics.

See col. 12, ll. 16-25 (emphasis added, passage teaches a “calibration pending indicator,” an “enter characteristic measurement prompt,” and a “characteristic measurement due prompt”). It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Schulze’s PDM 12A with the teachings of Reuss because both teachings relate to the internal status and proper functioning of a physiological measurement device.

### **Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant’s disclosure.

US 6,175,752 B1 teaches subject matter related to the Applicant’s claims (see col. 39, ll. 9-46, and col. 44, ll. 8-53). The Examiner suggests reviewing this patent before responding to the present Office Action.



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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Navin Natnithithadha whose telephone number is (571) 272-4732. The examiner can normally be reached on Monday-Friday, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Navin Natnithithadha  
Patent Examiner  
Art Unit 3735  
06/25/2007